

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 1-5, 7-8, 10, 14-20, 22-24, 35-39, 42, 44-46, 48** rejected under 35 U.S.C. 103(a) as being unpatentable over **Winston et al. (3,513,848)** in view of **Shikhman et al. (US 5,423,796)**.

**Winston et al.** discloses a device as shown in fig. 3A having two compression elements 57A and 46A. One is held rigidly to tube 70a and the other is slidably movable inside the outer tube. A spring 82a can bias the horn 57a either towards or away from anvil 46q. A source of ultrasonic power 71a is attached to the device.

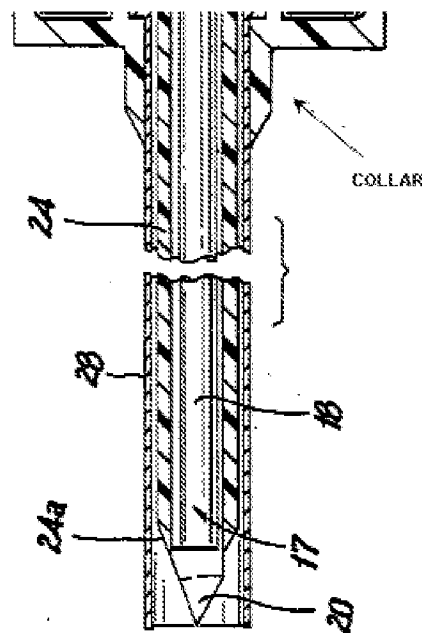
**Winston et al.** discloses the invention as claimed with the exception of the specific compressive force. As Winston discloses that this force varies depending on the

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suture used, the prior art force applied by the spring being within the claimed range would have been expected to perform the intended function of the tightening of the suture as it would be sufficient to grip the suture and hold it steady during melting. Winston also fails to provide the insulating sleeve.

**Shikhman et al.** discloses that it was known to provide an electrosurgical instrument with an outer insulating trocar sleeves. Additionally, **Shikhman et al.** teaches of a collar (FIG 2) that provides attachment of the sleeve to the housing as well as is capable of receiving an end portion of a suture by frictional engagement.

All of the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Given the teachings of **Shikhman et al.**, it would have been obvious to have provided Winston with such a sleeve, in order to protect the user and the patient from possible burns, while providing a sleeve through which the device could be inserted in order to suture internally.



4. **Claims 25 and 43** rejected under 35 U.S.C. 103 (a) as being unpatentable over **Winston et al.** in views of **Meade et al.** (US 5,478,351).

**Winston et al.** discloses a device as shown in fig. 3A having two compression elements 57A and 46A. One is held rigidly to tube 70a and the other is slidably movable inside the outer tube. A spring 82a can bias the horn 57a either towards or away from anvil 46q. A source of ultrasonic power 71a is attached to the device.

**Winston et al.** discloses the invention as claimed with the exception of the specific compressive force. As Winston discloses that this force varies depending on the suture used, the prior art force applied by the spring being within the claimed range would have been expected to perform the intended function of the tightening of the

suture as it would be sufficient to grip the suture and hold it steady during melting.

Winston also fails to provide the insulating sleeve.

**Meade et al.** teach that it was known to provide an electrosurgical instrument with an outer insulating sleeve. Additionally, **Meade et al.** teach of a trigger that biases the insulating sleeve into a position (Abstract, Column 6, Line 64, - Column 7, Line 2, Column 7, Lines 17-25).

All of the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Given the teachings of **Meade et al.**, it would have been obvious to have provided Winston with such a sleeve, in order to protect the user and the patient from possible burns and the ability to actuate the sleeve.

### ***Response to Arguments***

5. Applicant's arguments filed 3/25/2008 have been fully considered but they are not persuasive. **Shikhman et al.** clearly discloses that the "obturator shaft **18** slides within cannula sleeve **28**" (Column 4, Lines 24-30) to either cover (FIG 2) or expose (FIG 1) the obturator tip **20**. Cannula sleeve **28** is rigidly attached to cannula housing; however, the cannula sleeve and cannula housing can be moved in space as well as moved relative to the obturator. Therefore the sleeve is capable of sliding independently relative to the obturator.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **Yates et al. (US 5,403,312), Egan (US 6,106,545), and Ryan (US 6,267,761)** disclose related prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK MASHACK whose telephone number is (571)270-3861. The examiner can normally be reached on Monday-Thursday 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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